

DOCKET NO.: VTN-0601DIV
Application No.: 10/729,748

PATENT

REMARKS/ARGUMENTS

This amendment is being filed on February 9, 2006.

This amendment adds new claims 39-53. Support for the amendments may be found at:

Claims 39 & 40 – Examples 1-3
Claims 41- 43 – Example 1, page 12, lines 12-15.
Claims 44 and 46 – page 9, line 9
Claim 45 – Example 17
Claims 47-50 – page 9, line 18
Claim 51 Examples 1-19, 1-4
Claims 52 and 53 – page 9, lines 7-11.

Entry of newly added claims 39-53 is respectfully requested.

Rejections under 35 USC §112

Claim 1 was rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) at the time the application was filed, has possession of the claimed invention. The Examiner commented that he thought the limitation “wherein the surface of said plastic article is not pretreated prior to said immersing and wherein said aqueous solution contains no coupling agents” was new matter because the specification did not support such a “negative” limitation. In order to expedite prosecution, applicants will explain how their application supports this limitation.

Applicants note that MPEP 2173.05 specifically recognizes that negative limitations may be proper and explains, “Any negative limitation or exclusionary proviso must have a basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. * * * Note that lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support.”

This application describes the limitation “wherein the surface of said plastic article is not pretreated prior to said immersing and wherein said aqueous solution contains no coupling agents” (a) by not disclosing any pretreatment of the plastic article prior to the

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immersion of the plastic article in the solution of the polymer having carboxyl-functional groups and (b) by not disclosing the use of coupling agents for coupling the polymer layer to the plastic article substrate. Page 7, lines 13-18, indicates that the results of this invention were surprisingly produced by the "very simple treatment of immersing the plastic articles in at least one kind of aqueous solution," implying that the invention involves nothing more than the immersion claimed, without the need for conventional pretreatments or coupling agents. The Examples are similarly devoid of even a hint of pretreatment of the plastic article prior to immersion or the use of coupling agents. The Description of the Related Art starting at page 1, line 17, refers to prior art methods for imparting wettability to contact lenses using plasma treatment in an oxygen or carbon dioxide atmosphere and their disadvantages, while the Summary of the Invention starting at page 2, line 6, emphasizes that the invention provides good and stable wettability while leaving the good inherent properties of the article unchanged, implicitly by contrast with the prior art. Since the addition of the limitation "wherein the surface of said plastic article is not pretreated prior to said immersing and wherein said aqueous solution contains no coupling agents" does nothing more than recite what was implicit in the original disclosure of the invention of this application, it is not new matter because persons skilled in the art would recognize from the original disclosure that applicants invented what is now being claimed. See, MPEP 2163.01, "Whenever the issue arises, the fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date, the applicant was in possession of the invention as now claimed."

Claim 2 was amended to more clearly recite the claimed subject matter. Applicants do not believe that the amendments to claim 2 change the scope of the claim in any way.

Claims 6 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 6 has been amended to change the "X" to "x" as suggested by the Examiner. Claim 12 had been amended to depend from claim 2, and to state that the second polymer may be polyethyleneimine.

Rejections under 35 USC §102(b)

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Claims 1-8, 10-14 were rejected under 35 U.S.C. 102(b) as being anticipated by PCT 99/35520 (Winterton et al.).

Applicants respectfully disagree. Winterton et al. discloses alternately contacting lenses with a polycationic and polyanionic materials. According to Winterton, the first polyionic material is a polycationic material. See page 7, last paragraph. None of the first polyionic materials disclosed by Winterton comprise a polycarboxyl functional polymer as recited in the present claims. Moreover, as claim 1 clearly recites that the "surface of said plastic article is not pretreated prior to said immersing step" claim 1 is clearly novel in view of Winterton et al. Accordingly, Applicants respectfully request that 102 the rejection based upon Winterton be withdrawn.

There is also nothing in Winterton to suggest that a polycarboxyl functional polymer could be directly dip coated onto a plastic article which is not first contacted with a polycationic material. Winterton specifically proposes from page 17, last paragraph, through page 18, second paragraph, that the contact lens has transitory or permanent negative charges which provide ionic binding sites for the polycationic material. Accordingly, Applicants respectfully submit that Winterton et al. teaches away from the present invention. The present invention is therefore also not obvious in view of Winterton, et al.

Applicants respectfully submit that the foregoing amendments and arguments have traversed the objections and rejections made by the Examiner. Entry of the amendments and allowance of the claims is requested.

Rejections under 37 C.F.R. §1.98(a)(2)

The Examiner rejected the information disclosure under 37 CFR 1.98(a)(2) filed 1-21-05, because a copy of the European patent to Mobile Corp has been crossed out and not been considered. It appears the Examiner considered the remainder of the references cited. A new IDS citing only the Mobil patent, and a copy of the Mobil patent is submitted herewith.

Conclusions

Applicants request the Examiner to enter the amendments, reconsider and withdraw the standing rejections and objections of the claims; and pass claims 1-8, 10-14 and new claims 39-55 to allowance.

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If the Examiner is of a contrary view, the Examiner is requested to contact the undersigned attorney at (904) 443-3074.

Respectfully submitted,

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/Karen A. Harding/
Karen A. Harding
Registration No. 33,967

Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003
(904) 443-3074